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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,100

03/03/2004

Giuseppe Maio

1610-100

4098

30448

7590

09/18/2007

AKERMAN SENTERFITT

P.O. BOX 3188

WEST PALM BEACH, FL 33402-3188

EXAMINER

LANDAU, SHARMILA GOLLAMUDI

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

09/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/792,100	Applicant(s) MAIO ET AL.	
	Examiner Sharmila Gollamudi Landau	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-10 are pending in this application.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a composition comprising polyisoprene and a process of preparing a cosmetic composition comprising polyisoprene, classified in class 424, subclass 78.08.
- II. Claim 10, drawn to a method of preparing polyisoprene, classified in class 522 subclass 159.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, Invention II makes a materially different product, i.e. a polyisoprene than the product of invention I, a cosmetic comprising polyisoprene, an organic solvent, and oleophilic modified clay.

During a telephone conversation with Mark Passler on 9/5/07 a provisional election was made with traverse to prosecute the invention of I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin et al (5,945,095) in combination with Gatto et al (US 2003/0195486).**

Mougin et al teach skin care compositions and method of making the cosmetic composition containing a polyisoprene containing polymer, a wax, modified hectorite and an organic solvent, isododecane. The polymers have a molecular weight of 2000 to 10,000,000. See abstract, column 4, lines 33-36, column 5, line 23, column 7, lines 38-48, column 8, line 48 through column 10, line 24, Example 11. The amount of the polymer in examples 1 and 11 appear to fall within the amounts claimed. Instant claim language "a polyisoprene-containing cosmetic composition" reads on the diblock polymer containing polyisoprene taught by Mougin et al.

Mougin et al do not specify how the hectorite is modified.

Gatto et al while disclosing skin care compositions teach that clays modified with fatty acids provide dispersibility in oil based compositions and stability. Such clays include stearalkonium bentonites and hectorites. [0078].

Therefore, assuming that that the modified hectorites taught by Mougin et al are not fatty acid modified, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mougin and Gatto and specifically utilize fatty

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acid modified hectorites. One would have been motivated to do so with a reasonable expectation of success since Gatto et al teach fatty acid modified clays provide dispersibility in oil based compositions and stability and Mougin's composition is an oil-based composition.

**Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Veeger et al (6,471,983) as evidenced by Kraton IR 401 brochure of record in view of Viladot (20030044469).**

Veeger teaches skin composition comprising a) 10-80% polyisoprene, b) 1-15% by weight of an organic solvent, c) 0-10% by weight of at least one surfactant, d) 0-10% by weight of an abrasive, e) 0-1% by weight thickener, f) optionally cosmetic adjuvants and additives and/or active ingredients, g) 10-60% by weight water, to make a total of 100% by weight. See tables and claims. The isoprene utilized is Kraton IR 401. Veeger teaches the use of thickeners such as acrylic acid polymers and xanthan gum to modify the consistency of the composition.

Although Veeger teaches kaolin (clay) in the composition, Veeger does not teach the use of a modified clay.

The Kraton IR 401 brochure discloses that Kraton IR 401 has a molecular weight of 1,500,000-2,500,000.

Viladot teaches a skin care composition comprising consistency factors and thickeners such as xanthan gum, polyacrylate polymers, disteardimonium hectorite (BENTONE), etc. see [0058].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Veeger et al and Viladot and substitute the prior art's thickener with the instant thickener, disteardimonium hectorite. One would have been motivated

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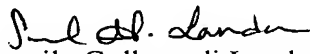
to do so since Viladot teaches both Veeger's exemplified thickeners and instant thickener function as consistency factors in cosmetics. Moreover, a skilled artisan would have reasonably expected success since Veeger generally teaches using thickeners to modify the consistency of the cosmetic. Therefore, it would have been prima facie obvious for a skilled artisan to utilize the appropriate thickener since the prior art establishes the functional equivalency between both.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila Gollamudi Landau whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Sharmila Gollamudi Landau  
Primary Examiner  
Art Unit 1616